

REMARKS

The Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-7, 10-11, 13-14, and 19-20 have been amended.

Claims 21-45 have been added to present claims of varying scope.

This amendment adds, changes and/or deletes claims in this Application. A detailed listing of claims that are, or were, in the Application, irrespective of whether the claim(s) remain under examination in the Application, is presented, with an appropriate defined status identifier.

Claims 1-7, 10-11, 13-14, and 19-45 are now pending.

The Applicants believe that the present Application is now in condition for allowance. Favorable reconsideration of the Application as amended is respectfully requested.

Claim Rejections – 35 U.S.C. § 102

On page 1 of the Office Action, the Examiner rejected independent Claims 1, 7, and 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,380,252 titled “Combined Trash Receptacle and Advertising Medium” issued to Richardson (“Richardson”) or U.S. Patent No. 5,069,343 titled “Stackable Recycling Storage Bin Apparatus” issued to Markle (“Markle”). The Examiner stated: “All the references show all the structures of the device as recited by the claims.” In addition, the Examiner stated:

Both Richardson and Markle may not show applicant’s disclosed invention, but they are deemed showing the claimed invention i.e. the passage having end portion and a slot on a side of the end portion.

No criticality is found in the claimed sizes and shapes, therefore, it would have been obvious to one having ordinary skill in the art to make the containers of Richardson and Markle out of any desired dimensions and shape for any desired result.

Markle is directed to a “stackable recycling storage bin apparatus” including a “lower container of a trapezoidal cross-sectional configuration accommodating a lid defined by a

further trapezoidal cross-section configuration, wherein the lid is complementarily received upon the container and includes a pivoted entrance door” (Abstract; and Figures 3-4, and 7).

Richardson is directed to a “combined trash receptacle and advertising medium” including “an opening 27 in one of the inclined faces of such top, and a cover 28 hinged to cover such opening at will. A chute 29 is formed of sheet material, comprising an upper, downwardly inclined wall 30, secured to the top side beyond the upper edge of opening 27, with side portions 31, which are substantially triangular with their base edges extending toward the opening 27” (see col. 2, line 130 and col. 3, lines 1-9; and Figures 1, and 3-4). In addition, Richardson describes that the “combined trash receptacle and advertising medium” is “made for the full utilization of the receptacle as an advertising carrier without addition or change in such receptacle” (see col. 1, lines 25-28; and Figures 1, and 3-4). Further, the “interior of the receptacle body is closed by a door 35 which is a substantial duplication in construction of one of the side walls of the receptacle” (see col. 3, lines 27-30; and Figures 1, and 3-4).

Claim 1 is in independent form and recites a “receptacle” comprising, in combination with other elements, a “base having an inner cavity and a removable liner received within the cavity of the base” wherein “the elongate member is configured to be removably coupled to the base so that the liner may be removed from within the cavity of the base by removing the elongate member from the base” and wherein “a substantial portion of the elongate member comprises a relatively small cross-section as compared to a cross-section of a substantial portion of the base.”

Markle and Richardson do not identically disclose a “receptacle” comprising, among other elements, a “base having an inner cavity and a removable liner received within the cavity of the base” wherein “the elongate member is configured to be removably coupled to the base so that the liner may be removed from within the cavity of the base by removing the elongate member from the base” and wherein “a substantial portion of the elongate member comprises a relatively small cross-section as compared to a cross-section of a substantial portion of the base” as recited in independent Claim 1. The rejection of Claim 1 over Markle and Richardson is improper. Claim 1 is patentable over Markle and Richardson.

Claim 7 is in independent form and is based substantially on independent Claim 1 from issued U.S. Patent No. 6,454,122 titled "Collection Device for Smoking Debris." However, Claim 7 replaces "an aperture" with "a slot." Claim 7 recites a "collection device for disposal of combustible debris" comprising, in combination with other elements, a "base," a "liner received within the base for easy removal and emptying," an "upper portion releasably mounted to the base, wherein the upper portion includes a side wall and a first open end that communicates with the base to a second closed end vertically spaced from the base, wherein the upper portion further includes an internal passage," and a "slot formed in the side wall of the upper portion, and communicates with the internal passage."

Markle and Richardson do not identically disclose a "collection device for disposal of combustible debris" comprising, among other elements, a "base," a "liner received within the base for easy removal and emptying," an "upper portion releasably mounted to the base, wherein the upper portion includes a side wall and a first open end that communicates with the base to a second closed end vertically spaced from the base, wherein the upper portion further includes an internal passage" as recited in independent Claim 7. The rejection of Claim 7 over Markle and Richardson is improper. Claim 7 is patentable over Markle and Richardson.

Claim 10 is in independent form and is based substantially on independent Claim 8 from issued U.S. Patent No. 6,454,122 titled "Collection Device for Smoking Debris." However, Claim 10 replaces "an aperture" with "a slot." Claim 10 recites a "collection device for disposal of combustible debris" comprising, in combination with other elements, a "base," an "upper portion mounted to the base" wherein "the upper portion includes an internal passage extending from an open first end that communicates with the base to a closed second end vertically spaced from the base, the upper portion including a side wall and having at least one aperture formed in the side wall, the aperture communicating with the internal passage adjacent the closed end of the internal passage" wherein "the closed second end of the upper portion comprises a cap member having a throat passage extension and a shield member" and wherein "the aperture is a first slot."

Markle and Richardson do not identically disclose a "collection device for disposal of combustible debris" comprising, among other elements, a "base," an "upper portion

mounted to the base” wherein “the upper portion includes an internal passage extending from an open first end that communicates with the base to a closed second end vertically spaced from the base, the upper portion including a side wall and having at least one aperture formed in the side wall, the aperture communicating with the internal passage adjacent the closed end of the internal passage” wherein “the closed second end of the upper portion comprises a cap member having a throat passage extension and a shield member” and wherein “the aperture is a first slot” as recited in independent Claim 10. The rejection of Claim 10 over Markle and Richardson is improper. Claim 10 is patentable over Markle and Richardson.

Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of Claims 1, 7, and 10.

Claim Rejections – 35 U.S.C. § 103(a)

On page 1 of the Office Action, the Examiner rejected Claims 1-7, 10, 11, 13, 14, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,380,252 titled “Combined Trash Receptacle and Advertising Medium” issued to Richardson (“Richardson”) or U.S. Patent No. 5,069,343 titled “Stackable Recycling Storage Bin Apparatus” issued to Markle (“Markle”). The Examiner stated that: “It would have been obvious to design the containers of Richardson and Markle in any desired size for any desired content.”

Markle is directed to a “stackable recycling storage bin apparatus” including a “lower container of a trapezoidal cross-sectional configuration accommodating a lid defined by a further trapezoidal cross-section configuration, wherein the lid is complementarily received upon the container and includes a pivoted entrance door” (Abstract; and Figures 3-4, and 7).

Richardson is directed to a “combined trash receptacle and advertising medium” including “an opening 27 in one of the inclined faces of such top, and a cover 28 hinged to cover such opening at will. A chute 29 is formed of sheet material, comprising an upper, downwardly inclined wall 30, secured to the top side beyond the upper edge of opening 27, with side portions 31, which are substantially triangular with their base edges extending toward the opening 27” (see col. 2, line 130 and col. 3, lines 1-9; and Figures 1, and 3-4). In addition, Richardson describes that the “combined trash receptacle and advertising medium” is “made for the full

utilization of the receptacle as an advertising carrier without addition or change in such receptacle” (see col. 1, lines 25-28; and Figures 1, and 3-4). Further, the “interior of the receptacle body is closed by a door 35 which is a substantial duplication in construction of one of the side walls of the receptacle” (see col. 3, lines 27-30; and Figures 1, and 3-4).

Claim 1 is in independent form and recites a “receptacle” comprising, in combination with other elements, a “base having an inner cavity and a removable liner received within the cavity of the base” wherein “the elongate member is configured to be removably coupled to the base so that the liner may be removed from within the cavity of the base by removing the elongate member from the base” and wherein “a substantial portion of the elongate member comprises a relatively small cross-section as compared to a cross-section of a substantial portion of the base.”

The “receptacle” recited in independent Claim 1 would not have been obvious in view of Markle or Richardson, alone or in any proper combination under 35 U.S.C. § 103(a). Neither Markle nor Richardson, alone or in any proper combination disclose, teach or suggest a “receptacle” comprising, in combination with other elements, a “base having an inner cavity and a removable liner received within the cavity of the base” wherein “the elongate member is configured to be removably coupled to the base so that the liner may be removed from within the cavity of the base by removing the elongate member from the base” and wherein “a substantial portion of the elongate member comprises a relatively small cross-section as compared to a cross-section of a substantial portion of the base.” To transform the “stackable recycling storage bin apparatus” of Markle or the “combined trash receptacle and advertising medium” of Richardson, into a “receptacle” with a “base having an inner cavity and a removable liner received within the cavity of the base” wherein “the elongate member is configured to be removably coupled to the base so that the liner may be removed from within the cavity of the base by removing the elongate member from the base” and wherein “a substantial portion of the elongate member comprises a relatively small cross-section as compared to a cross-section of a substantial portion of the base” (as recited in Claim 1) would require still further modification, and such modification is taught only by the Applicants’ own disclosure. The suggestion to modify the “stackable recycling storage bin apparatus” of Markle or the “combined trash

receptacle and advertising medium” of Richardson has been taken from Applicants’ own specification (using hindsight), which is improper.

Claim 7 is in independent form and is based substantially on independent Claim 1 from issued U.S. Patent No. 6,454,122 titled “Collection Device for Smoking Debris.” However, Claim 7 replaces “an aperture” with “a slot.” Claim 7 recites a “collection device for disposal of combustible debris” comprising, in combination with other elements, a “base,” a “liner received within the base for easy removal and emptying,” an “upper portion releasably mounted to the base, wherein the upper portion includes a side wall and a first open end that communicates with the base to a second closed end vertically spaced from the base, wherein the upper portion further includes an internal passage,” and a “slot formed in the side wall of the upper portion, and communicates with the internal passage.”

The “collection device for disposal of combustible debris” recited in independent Claim 7 would not have been obvious in view of Markle or Richardson, alone or in any proper combination under 35 U.S.C. § 103(a). Neither Markle nor Richardson, alone or in any proper combination disclose, teach or suggest a “collection device for disposal of combustible debris” comprising, in combination with other elements, a “base,” a “liner received within the base for easy removal and emptying,” an “upper portion releasably mounted to the base, wherein the upper portion includes a side wall and a first open end that communicates with the base to a second closed end vertically spaced from the base, wherein the upper portion further includes an internal passage,” and a “slot formed in the side wall of the upper portion, and communicates with the internal passage.” To transform the “stackable recycling storage bin apparatus” of Markle or the “combined trash receptacle and advertising medium” of Richardson, into a “collection device for disposal of combustible debris” with a “base,” a “liner received within the base for easy removal and emptying,” an “upper portion releasably mounted to the base, wherein the upper portion includes a side wall and a first open end that communicates with the base to a second closed end vertically spaced from the base, wherein the upper portion further includes an internal passage,” and a “slot formed in the side wall of the upper portion, and communicates with the internal passage” (as recited in Claim 7) would require still further modification, and such modification is taught only by the Applicants’ own disclosure. The suggestion to modify

the “stackable recycling storage bin apparatus” of Markle or the “combined trash receptacle and advertising medium” of Richardson has been taken from Applicants’ own specification (using hindsight), which is improper.

Claim 10 is in independent form and is based substantially on independent Claim 8 from issued U.S. Patent No. 6,454,122 titled “Collection Device for Smoking Debris.” However, Claim 10 replaces “an aperture” with “a slot.” Claim 10 recites a “collection device for disposal of combustible debris” comprising, in combination with other elements, a “base,” an “upper portion mounted to the base” wherein “the upper portion includes an internal passage extending from an open first end that communicates with the base to a closed second end vertically spaced from the base, the upper portion including a side wall and having at least one aperture formed in the side wall, the aperture communicating with the internal passage adjacent the closed end of the internal passage” wherein “the closed second end of the upper portion comprises a cap member having a throat passage extension and a shield member” and wherein “the aperture is a first slot.”

The “collection device for disposal of combustible debris” recited in independent Claim 10 would not have been obvious in view of Markle or Richardson, alone or in any proper combination under 35 U.S.C. § 103(a). Neither Markle nor Richardson, alone or in any proper combination disclose, teach or suggest a “collection device for disposal of combustible debris” comprising, in combination with other elements, a “base,” an “upper portion mounted to the base” wherein “the upper portion includes an internal passage extending from an open first end that communicates with the base to a closed second end vertically spaced from the base, the upper portion including a side wall and having at least one aperture formed in the side wall, the aperture communicating with the internal passage adjacent the closed end of the internal passage” wherein “the closed second end of the upper portion comprises a cap member having a throat passage extension and a shield member” and wherein “the aperture is a first slot.” To transform the “stackable recycling storage bin apparatus” of Markle or the “combined trash receptacle and advertising medium” of Richardson, into a “collection device for disposal of combustible debris” with a “base,” an “upper portion mounted to the base” wherein “the upper portion includes an internal passage extending from an open first end that communicates with the

base to a closed second end vertically spaced from the base, the upper portion including a side wall and having at least one aperture formed in the side wall, the aperture communicating with the internal passage adjacent the closed end of the internal passage” wherein “the closed second end of the upper portion comprises a cap member having a throat passage extension and a shield member” and wherein “the aperture is a first slot” (as recited in Claim 10) would require still further modification, and such modification is taught only by the Applicants’ own disclosure. The suggestion to modify the “stackable recycling storage bin apparatus” of Markle or the “combined trash receptacle and advertising medium” of Richardson has been taken from Applicants’ own specification (using hindsight), which is improper.

Accordingly, the “receptacle” recited in independent Claim 1 and the “collection device for disposal of combustible debris” recited in independent Claims 7 and 10, considered as a whole, would not have been obvious in view of Markle or Richardson. The rejection of Claims 1-7, 10, 11, 13, 14, 19, and 20 in view of Markle or Richardson under 35 U.S.C. § 103(a) is improper. Therefore, Claims 1, 7, and 10 are patentable over Markle and Richardson.

Dependent Claims 2-6, 11, 13, 14, 19, and 20, which depend from independent Claims 1, 7, and 10, are also patentable. See 35 U.S.C. § 112 ¶ 4.

Applicants respectfully request withdrawal of the rejection of Claims 1-7, 10, 11, 13, 14, 19 and 20 under 35 U.S.C. § 103(a).

Added Claims

New Claims 21-45 have been added to present claims of varying scope. New Claim 21 depends from independent Claim 1. New Claims 22-31 depend from independent Claim 7. New Claims 32-45 depend from independent Claim 10. Independent Claims 1, 7 and 10 are patentable. Therefore, dependent Claims 21-45 are also patentable. See 35 U.S.C. § 112 ¶ 4.

New Claims 21-45 are believed to be patentable over the cited references of record.

Nonstatutory Double Patenting Rejection

On page 2 of the Office Action, the Examiner rejected Claims 1-7, 10, 11, 13, 14, 19 and 20 under the judicially created doctrine of double patenting over the patented Claims of U.S. Patent No. 6, 185,355 to Luedecke. A terminal disclaimer signed by an attorney of record is provided to overcome this rejection. Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 1-7, 10, 11, 13, 14, 19 and 20 under the judicially created doctrine of double patenting.

* * *

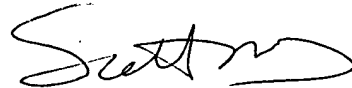
The Applicants respectfully submit that each and every outstanding objection and rejection has been overcome, and the present Application is in a condition for allowance. The Applicants request reconsideration and allowance of pending Claims 1-7, 10-11, 13-14, and 19-40.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present Application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this Application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to the Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extension fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 4/9/04

By 

FOLEY & LARDNER LLP
Suite 3800
777 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-5306
Telephone: (414) 297-5872
Facsimile: (414) 297-4900

Scott M. Day
Attorney for Applicants
Registration No. 52,801